

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MING JANG HWANG, KEIZO HOSODA,
SHINTARO AOYAMA, TADASHI TERASAKI
and TSUYOSHI TAMARU

Appeal No. 2002-2055
Application No. 09/727,547

ON BRIEF

Before COHEN, ABRAMS, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9-14.
Claims 1-8 have been canceled and claims 15-20 withdrawn from consideration as
being directed to a non-elected invention.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a method of reducing by-product deposition inside wafer processing equipment. An understanding of the invention can be derived from a reading of exemplary claim 9, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Comita <u>et al.</u> (Comita) (U.S. Patent Application Publication)	US2001/0008618A1	Jul. 19, 2001
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Nozaki <u>et al.</u> (Nozaki) (Japanese Kokai Patent application)	SHO 61[1986]-117824	Jun. 5, 1986 ¹
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Claims 9, 11 and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Comita.

Claims 9-12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Comita.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Comita in view of Nozaki.²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants, we make reference to the Answer (Paper No. 14) for the examiner's

¹Our understanding of this foreign language document was obtained from a PTO translation, a copy of which is enclosed

²Three final rejections of the claims which incorporated Ikeda U.S. Patent No. 5,819,683 as a reference were withdrawn in the Answer (page 2).

reasoning in support of the rejections, and to the Brief (Paper No. 13) and the Reply Brief (Paper No. 15) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The appellants have explicitly withdrawn all traversals to the rejections made by the examiner except for their argument that Comita is not applicable as a reference by reason of its effective date (Reply Brief, page 2). Thus, this becomes the dispositive issue in the case.

Comita was filed on Oct. 7, 1998, and was published on June 19, 2001. The present application was filed on Dec. 4, 2000, as a division of Serial No. 09/354,459, filed on July 15, 1999, which claimed the benefit of the filing date of U.S. Provisional Application No. 60/070,697, filed Jan. 7, 1998. Thus, if the present application were entitled to the filing date of the provisional application (Jan. 7, 1998), Comita (Oct 7, 1998) would be antedated as a reference against the claims that are before us. However, it turns out that this is not the case. Provisional applications are automatically abandoned twelve months after their filing date (35 U.S.C. § 111(b)(5)), and therefore the term of the appellants' provisional application expired on Jan. 7, 1999, some seven

months prior to the filing date of Serial No. 09/354,459, the parent of the present application. Thus, there is no copendency between the provisional application and the parent application and, on this basis, the examiner considered Comita to be a proper reference, inasmuch as it was filed prior to the filing date of the parent of the present application. The examiner's position explicitly is supported by 35 U.S.C. § 119(e)(1), which states that an application is entitled to the filing date of a provisional application if, among other requirements stated therein, the application is "filed not later than twelve months after the date on which the provisional application was filed."

The appellants have stated on page 4 of the Brief that "it is apparent that the benefit of the provisional application Serial No. 60/070,697 cannot be claimed for priority purposes," thus apparently acknowledging that the copendency requirement of 35 U.S.C. § 119(e)(1) regarding the parent to the present application and the provisional application has not been met. Nevertheless, the appellants seek to remove Comita as a reference on the basis of the following argument (Brief, pages 4 and 5):

Since Comita et al. is not a statutory bar, the provisional application establishes a date of constructive reduction to practice or conception with diligence prior to the filing date of Comita et al. Furthermore, 35 U.S.C. § 119(e)(2) states that "A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) has been paid.[]" These requirements have been complied with in the case of the provisional application. Accordingly, it follows that the provisional application **may** be relied upon and such reliance is made herewith. It would appear that the only loss of rights would result from a reference having a statutory bar date in the window between filing of the parent of the subject application and abandonment of

the provisional application. That is not the case herein. It follows that Comita et al. is not applicable as a reference in this application. The priority benefit discussed in the Office action is not the benefit being relied upon.

The appellants have cited no legal precedent in support of this position, which appears to us to be contrary to 35 U.S.C. § 119(e)(1) and 35 U.S.C. § 120, and to be based on the proposition that provisional applications are treated differently than other applications with regard to obtaining the benefit of an earlier filing date.

We therefore share the examiner's view that the lack of copendency between the provisional application and the parent to the present application results in Comita being a proper reference against the claims in the present application. This being the case, and in the absence of arguments on the part of the appellants that the claims are patentable over the references applied by the examiner, we shall sustain all of the rejections.

CONCLUSION

All three of the rejections are sustained.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

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APPEAL NO. 2002-2055 - JUDGE ABRAMS
APPLICATION NO. 09/727,547

APJ ABRAMS

APJ STAAB

APJ COHEN

DECISION: **AFFIRMED**

Prepared By: Lesley Brooks

OB/HD

GAU: 2800

DRAFT TYPED: 09 Jan 04

FINAL TYPED: